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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/988,515 | 11/20/2001 | Louis Robert Litwin | PU 010262 | 8633 |

7590

09/21/2005

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EXAMINER

LEZAK, ARRIENNE M

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/988,515

Applicant(s)

LITWIN ET AL.

Examiner

Arrienne M. Lezak

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Examiner notes that Claims 8, 16 & 17 have been amended, and no claims have been added or canceled. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 25 March 2005 as reiterated herein below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8, 16 & 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, Examiner notes that Applicant has failed to adequately describe the means or method by which a user is able to play a message, "with just one push of a button". Examiner notes that Applicant has removed the word "single"; however, the remaining wording "a button" still implies the use of only one button, and as such is an insufficient amendment to overcome the 35 U.S.C. 112, first paragraph rejection. Without proper description, (and respective specification support), Examiner requires removal of the same.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of the teachings of US Patent 6,085,101 to Jain.

5. Regarding Claims 1 & 9, Jain discloses a system and method for playing back a voicemail message sent to multiple recipients, (Abstract), comprising the steps of:

- receiving an input that selects the multiple recipients from a stored list of users, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-35);
- sending phone numbers of the multiple recipients to a temporary voicemail server, in response to said receiving step, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-35);
- receiving a voicemail message, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-35);
- determining Internet Protocol (IP) addresses of the multiple recipients from
- the phone numbers, by the temporary voicemail server, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-

Art Unit: 2143

35), (Examiner notes that Jain discloses a database of user information which information includes both telephone and email (IP) addresses, and wherein the user enters the message, the address list and other requested information, which "other information" would obviously include any data needed for proper recognition and location of the intended recipient. That noted, Examiner finds that it would have been obvious to one of ordinary skill in the art at the time of invention of Applicant to use a relational database, wherein the any information entered, (i.e.: phone number), would in turn cause an immediate determination of all recipient information including, but not limited to IP address for the same); and

- sending IP packets that include the voicemail message to any of the multiple recipients that have an active mobile terminal, (Col. 2, lines 12-18; Col. 8, lines 1-35; & Col. 13, lines 30-49), wherein the input and the voicemail message received at said receiving steps are provided by an originating sender of the voicemail message, (Col. 8, lines 1-35).

Thus, Claims 1 & 9 are found to unpatentable over considerable consideration of the teachings of Jain.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US Patent 6,085,101 to Jain in view of US Patent Pub. US 2002/0165894 A1 to Kashani.

Art Unit: 2143

7. Regarding Claims 1, 8, 9, 16 & 17, Jain in view of Kashani discloses a system and method for playing back a voicemail message sent to multiple recipients, (Abstract; Col. 3, lines 24-67; & Col. 5, lines 1-41), comprising the steps of:

- receiving an input that selects the multiple recipients from a stored list of users, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-35);
- sending phone numbers of the multiple recipients to a temporary voicemail server, in response to said receiving step, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-35);
- receiving a voicemail message, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-35);
- determining Internet Protocol (IP) addresses of the multiple recipients from
- the phone numbers, by the temporary voicemail server, (Col. 2, lines 12-18; Col. 6, lines 26-67; Col. 7, lines 1-48; & Col. 8, lines 1-35), (Examiner notes that Jain discloses a database of user information which information includes both telephone and email (IP) addresses, and wherein the user enters the message, the address list and other requested information, which "other information" would obviously include any data needed for proper recognition and location of the intended recipient. That noted, Examiner finds that it would have been obvious to one of ordinary

Art Unit: 2143

skill in the art at the time of invention of Applicant to use a relational database, wherein the any information entered, (i.e.: phone number), would in turn cause an immediate determination of all recipient information including, but not limited to IP address for the same); and

- sending IP packets that include the voicemail message to any of the multiple recipients that have an active mobile terminal, (Col. 2, lines 12-18; Col. 8, lines 1-35; & Col. 13, lines 30-49), wherein the input and the voicemail message received at said receiving steps are provided by an originating sender of the voicemail message, (Col. 8, lines 1-35).

8. Though Jain discloses recipients receiving the message and cellular/PDA wireless technology, Jain does not specifically disclose playing back the voicemail message on a mobile terminal of a given one of the multiple recipients, upon a single button being actuated on the mobile terminal of the given one of the multiple recipients, (per pending Claims 8, 16 & 17). Examiner notes that in light of Jain, it would be obvious to play a received voicemail message on a mobile device. Regarding the "single button" functionality, Examiner provides Kashani, which teaches cellular technology and macros utility programs which programs provide shortcuts to functions and processes such as performing multi-step operations, (Kashani – paragraphs #0008 – 0011). To incorporate the Kashani macro utility program into the Jain wireless apparatus would have been obvious as a means for simplifying the voicemail retrieval (multi-step) process.

Art Unit: 2143

Thus, Claims 1, 8, 9, 16 & 17 are found to be unpatentable over the combined teachings of Jain and Kashani.

9. Regarding Claims 2-4, 10-12 & 18-20, Jain in view of Kashani discloses a system and method for playing back a voicemail message sent to multiple recipients further comprising the step of deleting the message from the temporary voicemail server after all of the multiple recipients have received the voicemail message, (per pending Claims 2, 4, 10, 12, 18 & 20), (Col. 12, lines 42-61), or have had the voicemail message copied to the voicemail mailbox, (per pending Claims 3, 4, 11, 12, 19 & 20), (Col. 14, lines 12-34). Examiner notes that Jain teaches a "calling record", which record would allow the server to assess whether all the recipients had received the message. Additionally, Examiner notes that upon receiving a confirmation the message had been received by all intended recipients, it would have been obvious for the server to delete the message so as to avoid maintenance of "stale" messages, (Jain – Col. 3, lines 29-32), and unnecessary use of resources, (memory). Thus, Claims 2-4, 10-12 & 18-20 are found to be unpatentable over the combined teachings of Jain and Kashani.

10. Regarding Claims 5, 6, 13 & 14, Jain in view of Kashani discloses a system and method for playing back a voicemail message sent to multiple recipients wherein the IP packets further include a notification message that notifies a receiving recipient that a mobile terminal of the receiving recipient has received the voicemail message, (per pending Claims 5 & 13), and an identity of the originating sender of the voicemail message, (per pending Claims 6 & 14),

Art Unit: 2143

(Col. 12, lines 8-67; Col. 13, lines 1-29; & Col. 14, lines 12-34). Examiner notes that Jain discloses returning responses to a multicast, which functionality obviously requires message notification and sender identification, especially in the event that a timely and immediate reply is required to be made to a particular sending party. Thus, Claims 5, 6, 13 & 14 are found to be unpatentable over the combined teachings of Jain and Kashani.

11. Regarding Claims 7 & 15, Jain in view of Kashani discloses a system and method for playing back a voicemail message sent to multiple recipients wherein the stored list of users is comprised in an address book stored on a mobile terminal of the originating sender, (Col. 1, lines 31-35 & Col. 3, lines 44-67). Examiner notes that cellular telephones and personal digital assistants, (mobile terminals), are well-known in the art to maintain address book information, which information is available per network server query of the same. Thus, Claims 7 & 15 are found to be unpatentable over the combined teachings of Jain and Kashani.

Response to Arguments

12. Applicant's arguments filed 27 June 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

Art Unit: 2143

13. Regarding Applicant's argument that Jain does not disclose determining IP addresses of the multiple recipients from the phone numbers, by the temporary voicemail server, Examiner respectfully disagrees noting the teaching of temporary servers was obviously well-known at the time of invention by Applicant as noted within Jain which clearly describes the use of a Home Location Register, (HLR), and a Visiting Location Register, (VLR), wherein the VLR obviously only temporarily maintains user data when visited by the portable user device, which user data is obviously maintained by and acquired from the HLR on an as needed basis, as maintenance of all user data at every server location would require massive amounts of memory and a means to constantly update each database, making the same cost-prohibitive and wasteful, (Col. 1, lines 55 & Col. 2, lines 1-26).

14. Additionally, Jain specifically teaches multicasting with a look-up relational functionality, (Col. 3, lines 44-67), utilizing a Call Processing Record, (CPR), which may be an existing list or directory of recipient information which determine message delivery, in addition to an IP network server and a network database, wherein all data for proper transmission of messages would be available and easily referenced, (Col. 6, lines 18-67 & Col. 7, lines 1-21). Examiner additionally finds that a user obviously enters data within a database; however, a user need not know all data relevant to a particular transmission if a relational database is available for determining the same. Therefore, for example, in the event that the user only had the telephone number of the intended recipient, the Internet

Art Unit: 2143

network server would obviously be able to locate/determine an email address from the network relational database or stored recipient list, as noted herein.

15. Thus, Examiner has addressed Applicant's Amendment, and has further rejected all claims, as noted herein above. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The

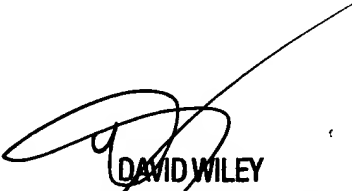
Art Unit: 2143

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
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Art Unit 2143

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